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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,831	02/28/2006	Shinji Nakade	Q93540	8160

65565 7590 03/08/2010

SUGHRUE-265550
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EXAMINER	
DAVIS, ZINNA NORTHINGTON	
ART UNIT	PAPER NUMBER
1625	

NOTIFICATION DATE	DELIVERY MODE
03/08/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/569,831	NAKADE ET AL.	
	Examiner	Art Unit	
	Zinna Northington Davis	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 November 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,16,19,20,22,25,27-35 and 37-41* is/are pending in the application.

4a) Of the above claim(s) *40 and 41* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,27 and 37-39* is/are rejected.

7)☒ Claim(s) *16, 19, 20, 22, 25, 28-35* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/20/09;2/19/10;2/23/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 5, 16, 19, 20, 22, 25, 27-35, and 37-41 are pending.

2. Claims 2- 4, 6-15, 17, 18, 21, 23, 24, 26, 36, 42, and 43 have been canceled.

3. Based upon the response filed November 23, 2009, the improper Markush objection and election of species are withdrawn.

4. Based upon the response filed November 23, 2009, the rejections based upon 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 102(b) based upon Shen et al. are withdrawn.

5. Based upon the withdrawal of the species election, the search has been extended. The following rejections are applicable.

6. Claims 40 and 41 are withdrawn from consideration. These claims have not been canceled.

7. Rejoinder of the method claims will be addressed upon allowance of claimed subject matter.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 27, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claims 1, 27, and 37 are rejected

due to claiming a "prodrug" of a compound of Formula (I). The instant specification defines prodrug at page 46 as being employed herein includes esters and carbonates formed by reacting one or more hydroxyls of compounds of formula I with alkyl, alkoxy, or aryl substituted acylating agents employing procedures known to those skilled in the art. According to Wikipedia, prodrugs can be classified into two types based on their sites of conversion into the final active drug form: Type I, those that are converted intracellularly (e.g., anti-viral nucleoside analogs, lipid-lowering statins, antibody-directed/gene-directed enzyme prodrugs [ADEP/GDEP] for chemotherapy), and Type II, those that are converted extracellularly, especially in digestive fluids or the systemic circulation (e.g., etoposide phosphate, valganciclovir, fosamprenavir). Both types can be further categorized into subtype A or B, based on additional criteria. Those for the Type IA and IB are whether or not the cellular converting location is the site of therapeutic action. For the Type IIA and IIB, they are categorized depending on whether the conversion occurs in the gastrointestinal (GI) fluids or systemic circulation. At page 2, see Wu et al (cited by the Examiner). The scope of prodrug thereof is beyond the examples described in the instant specification. Therefore, such "prodrug" of the Formula (I) is not described in the specification to reasonably convey one skilled in the art, and fails to comply with the written description requirement.

10. Claims 1, 38, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. R^1 represents a substituent. Can that substituent represent hydrogen?

B. At claim 1, it is suggested that the term “group” should be added at radical, B.

C. At claim 1, penultimate line, applicant is queried for the proviso which has been added by amendment.

D. At claims 38 and 39, what chemical compounds are intended? Clarification is requested.

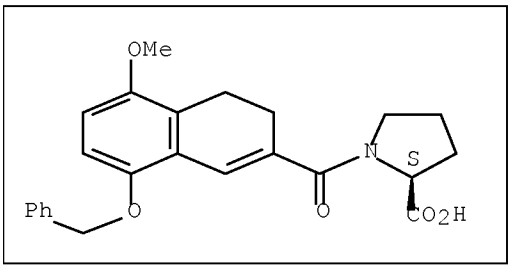
11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Warrener et al. (Reference U, cited by the Examiner).

The instantly claimed compound is disclosed. At page 1100, 2nd column, see compound 8. At page 1101, 1st column, see the Table wherein compound 8 is prepared. The compound is depicted below:



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The claims are fully met when D^1 represents a nitrogen-containing heterocyclic ring; Y^{1-3} represents methylene which has a substituent; B represents a

dihydronaphthalene group; X represent -CH_2–O-; A represents a cyclic group; R^1 represents a substituent which is hydrogen; m and n represent 1.

13. Claims 16, 19, 20, 22, 25, 28-35 are objected to.

14. The Information Disclosure Statements filed November 20, 2009, February 19, 2010, and February 23, 2010 have been considered.

15. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

18. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
Art Unit 1625

Znd
02.26.2010